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Remarks

This communication is responsive to the Office Action of October 26, 2007. Reexamination and reconsideration of claims 1-30 is respectfully requested.

Summary of The Final Office Action

Claims 1-9, 21-26 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3, 5-7, 9-12, 15-18, 21-28 were rejected under 35 U.S.C. §102(e) as being anticipated by Thayer (U.S. Pub. No. 2002/0116604 A1).

Claims 4, 8, 13-14, 19, 24, 29-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thayer, in view of Zimmer et al. (US Patent Publication 2005/0010811).

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35 U.S.C. §101 Rejection

Claims 1-9, 21-26 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant respectfully notes that no authority to support the rejection was provided in the Office Action (see page 2). Rejections must be based on substantive law. MPEP 2107. I, first paragraph states. "Rejections will be based upon the substantive law ..." No substantive law has been cited in the Office Action to support the §101 rejections and the rejections cannot stand.

MPEP 2106 "Patent Subject Matter Eligibility" requires in section VII:

VII. CLEARLY COMMUNICATE FINDINGS, CONCLUSIONS AND THEIR BASES

Once USPTO personnel have concluded the above analyses of the claimed invention under all the statutory provisions, including **35 U.S.C. 101, 112, 102 and 103**, they should review all the proposed rejections and their bases to confirm that they are able to set forth a *prima facie* case of unpatentability. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions and reasons which support them.

Independent Claim 1

The examiner's reasoning appears to be that since claim 1 includes a logic that may include a software element, it is per se non statutory since no findings, reasons, or laws were provided.

MPEP 2106 section IV "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. §101, (A), paragraph 7, states:

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena.

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MPEP 2106, section IV(C) also lists a series of tests that the examiner should complete prior to rejecting a claim under §§101 as stated in MPEP 2106 IV(D). Performing those tests shows that the present claims are statutory subject matter.

<u>Independent Claim 21</u>

Independent Claim 21 recites "[a] computer-readable medium for providing processor executable instructions operable to perform a method." This is a standard Beauregard claim that has been ruled to be statutory subject matter. In re Beauregard, 35 USPQ2d 1383 (Fed. Cir. 1995). MPEP 2106.01 also states that this claim type is statutory:

MPEP 2106.01, Section I, paragraph 2, states:

"In contrast, a <u>claimed computer-readable medium encoded with a computer</u> program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and <u>is thus statutory</u>. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035." (emphasis added)

Therefore, the present rejection is contrary to the MPEP and case law. Claim 21 is statutory and the rejection should be withdrawn.

<u>Independent Claim 25</u>

Claim 25 is a standard means-plus-function claim. Since it clearly is not an abstract idea, law of nature or natural phenomena, it is statutory. The rejection should be withdrawn.

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The Claims Patentably Distinguish Over the References of Record

I. Claims 1-3, 5-7, 9-12, 15-18, 21-26 were rejected under 35 U.S.C. §102(e) as being anticipated by Thayer (U.S. Pub. No. 2002/0116804 A1).

35 U.S.C. §102

For a 35 U.S.C. §102 reference to anticipate a claim, the reference must teach each and every element of the claim. Section 2131 of the MPEP recites:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 63`, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent Claim 1

This claim is directed to a system for securing ports. The claim recites:

a security logic configured to, in response to the security option being selected, cause the data store to be modified by changing the port count to specify a fewer number of physical ports to cause an operating system to not detect the one or more selected ports.

Thayer does not disclose this feature.

Thayer is very different from claim 1. Thayer teaches a system "for enabling a hidden port in a computing device" where a "hidden port ... is a port that is externally inaccessible to a user of the computing device and is not dedicated for general input/output (I/O) purposes (see Summary of Invention, para. [0015]).

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Thayer teaches that the port is physically hidden from a user by being internal to a computer:

[0028] . . the port is directly attached to the motherboard and can only be reached by opening a legacy-free machine..."

[0060] With respect to the present invention, the most generalized term is recognized as a "hidden port". A "hidden port" is defined as: (1) a port that is not externally accessible (i.e., externally inaccessible) to an end user, typically being internal to a computing device in some manner; and (2) a port that is not dedicated for general purpose use. (Thayer, page 6, [0060])

The "hidden port", which is a debug port, is not hidden from the computer itself or its operating system. If the debug port is present, it is detected by the operating system. The process of Thayer only works if the debug port is detected by the system ('Thayer page 5, [0051] 'Assuming that a hidden port is present on a system and has been detected . . .'). The only way Thayer can reconfigure the debug port is if it is detected by the system.

Thayer teaches that the port is always detectable by the system and Thayer discloses nothing that causes the port to be undetectable by the operating system. Thayer reconfigures the debug port by copying its address to a memory location of a desired COM port ('Thayer page 5, [0050]). Thus, Thayer fails to teach anything that changes the port count to specify a fewer number of physical ports as recited in claim 1. A prima facie anticipation rejection has not been established and the rejection should be withdrawn.

Since this claim recites features not taught or suggested by the reference, it patentably distinguishes over the reference. Accordingly, dependent claims 2-9 also patentably distinguish over the reference and are in condition for allowance.

<u>Independent Claim 10</u>

Claim 10 recites a computing system comprising one or more front and back ports positioned on a housing. Thayer fails to teach a system with both front and back ports as claimed. Figure 1A of Thayer shows a motherboard and this fails to

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anticipate a housing of a computing system having front and back ports. Figure 1C of Thayer illustrates a Legacy free system unit 150 and a debug console system 170 with cables connected behind their boxes. Thus at best, back ports may be implied but no front ports are taught or suggested. Therefore, Thayer fails to teach these claimed features and fails to anticipate claim 10. The rejection is improper for at least this reason.

Claim 10 further recites:

an operating system configured to enumerate ports that are present in the computing system based on the structural parameter, the structural parameter causing the one or more front ports to be undetectable by the operating system causing the one or more front ports to be inoperable.

Based on the explanation of Thayer above, Thayer fails to teach that ports can be made to be undetectable by the operating system. The debug port in Thayer is always detected by the operating system even when it is disabled. Being disable means the user cannot use the port but it is nevertheless detectable by the operating system. Therefore, Thayer fails to teach these claimed features and fails to anticipate claim 10. The rejection is improper and should be withdrawn. Claim 10 and dependent claims 11-15 should now be allowed.

Independent Claim 16

As explained above, Thayer is very different from the present application. In view of the discussion above, Thayer fails to teach every element of claim 16. Thayer fails to establish a prima facie anticipation rejection and the rejection should be withdrawn. Claim 16 and dependent claims 17-20 should now be allowed.

Independent Claim 21

Based on the explanation of Thayer, Thayer fails to teach anything related to "specifying a reduced number of physical ports," "changing a configuration

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parameter that indicates, to an operating system, the actual number physical ports....", or "causing the operating system not to enumerate the one or more ports" as recited in claim 21. Thayer fails to establish a prima facie anticipation rejection and the rejection should be withdrawn. Claim 21 and dependent claims 22-24 should now be allowed.

Independent Claim 25

In view of the discussion above, Thayer fails to teach any means for causing an operating system to not enumerate a selected port. All of the reconfiguration options taught by Thayer still cause the debug port to be detected by the operating system. Thayer fails to discuss ways to cause an operating system to not enumerate a port, thus Thayer fails to anticipate this feature.

Claim 25 also recites that the security means modifies a port count to specify one less port than a total number of the set of physical ports. Thayer fails to discuss this feature and none of the cited sections discuss this. A prima facie anticipation rejection has not been established for this additional reason. Claim 25 and dependent claim 26 should now be allowed.

Independent Claim 27

Claim 27 was rejected with the same rationale and citations of Thayer as applied against claim 1 (Office Action page 3). However, claim 27 recites different elements from claim 1 but the specific elements from claim 27 were not addressed. Thayer fails to anticipate claim 1 and fails to claim 27 as well.

For example, claim 27 recites:

"in response to the data entry selection signal ... the configuration parameter stores a value that specifies a total number of physical ports that are present in the computer system, the operation causing the value to be reduced in response to the security status for a selected port being set to

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indicate a secured status to cause an operating system not to enumerate the selected port.

The cited sections of Thayer does not discuss reducing a configuration value that specifies a total number of ports and does not discuss anything related to causing an operating system not to enumerate a port. In Thayer, even when its debug port is disabled, the port is still detected and controlled by the operating system. Thayer fails to discuss anything related to not enumerating a port. A prima facie anticipation rejection has not been established. Claim 27 should now be allowed.

II. Claims 4, 8, 13-14, 19, 24, 29-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thayer, in view of Zimmer et al. (US Patent Publication 2005/0010811).

Zimmer [0022] is cited by the Office Action against claims 4, 8, 13-14, 19, 24, 29-30. Zimmer [0022] discloses that System Management Mode (SMM) code is hidden from an operating system, in particular.

[0022] ... SMM has been available on IA32 (Intel Architecture 32 bit) processors as an operation mode hidden to operating systems that executes code loaded by BIOS or firmware. SMM is a special-purpose operating mode provided for handling system-wide functions like power management, system hardware control, or proprietary OEM-designed code. The mode is deemed "hidden" because the operating system (OS) and software applications cannot see it, or even access it.

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SMM code that is hidden from an operating system has no relevance to systems and methods of securing parts of the present application. For example, hidden SMM code has no relevance to reducing a number in a controller field to cause an operating system to be unaware of one or more companion controllers as in present claim 4. Thus, Zimmer is unrelated to the present application and fails to cure the deficiencies of Thayer.

The combined references fail to establish a prime facie obviousness rejection and the rejection should be withdrawn. Claims 4, 8, 13-14, 19, 24, 29-30 patentably distinguish over the references of record and should be allowed.

<u>Conclusion</u>

For the reasons set forth above, claims 1-30 are now in condition for allowance. An early allowance of the claims is earnestly solicited.

Respectfully submitted,

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